

### **REMARKS/ARGUMENTS**

The above-identified patent application has been reviewed in light of the Examiner's Action dated July 24, 2008. Claims 1-14 are amended with the filing of this Amendment and Response. New Claim 15 is presented for the first time. Claims 1-15 are now pending. As set out more fully below, reconsideration and withdrawal of the rejections to the Claims are respectfully requested.

#### **Objection to Specification and Abstract:**

The Examiner objected to the disclosure because of informalities and for failing to include the appropriate titles for each of the sections of the disclosure. After reviewing the specification as originally filed, Applicants' first preliminary amendment and the publication of this application, it appears that several typographical errors have been made in converting the originally filed application to the current published application. For example, in Applicants' originally filed application, when read with Applicants' first preliminary amendment, there is no quotation mark prior to the title of the invention, and the title "Brief Description of the Drawings" and "Abstract" are included in the proper place. In addition, a number of editorial revisions that were in Applicants' disclosure appear to have been made in the published application. Therefore, Applicants respectfully request that the Examiner reconsider these objections. Applicants are willing to submit a substitute specification if the Examiner so requests.

#### **Objection to Claim 10:**

The Examiner also objected to Claim 10 on the basis of informality. Claim 10 has been amended, and therefore this objection is now believed moot.

#### **Rejection of Claims 1-14 under 35 U.S.C. § 112, Second Paragraph:**

Claims 1-14 have been rejected under 35 U.S.C. § 112, ¶ 2. Applicants have addressed each of those rejections by appropriate amendments to the claims. Therefore, the rejection of Claims 1-14 on this basis should be withdrawn.

**Rejection of Claims 1, 3-7, 9-11 and 13-14 under 35 U.S.C. § 103(a):**

The Examiner rejected Claims 1, 3-7, 9-11, and 13-14 under 35 U.S.C. § 103(a) as unpatentable over Battigelli et al. (U.S. Pat. No. 5,601,628) in light of Jensen et al. (U.S. Pat. No. 5,614,449), and in further review of Vignesoult et al. (U.S. Pat. No. 6,284,684).

Applicants respectfully assert that the Examiner has failed to present a *prima facie* case of obviousness. It is the Examiner's burden to present evidence that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, and would have had a reasonable expectation of success in doing so. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006); *Noelle v. Lederman*, 355 F.3d 1343, 1351-52 (Fed. Cir. 2004); *Brown & Williamson Tobacco Co. v. Philip Morris, Inc.*, 229 F.3d 1120, 1121 (Fed. Cir. 2000); *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007). This burden requires the Examiner to show that one of ordinary skill in the art, motivated by the general problem facing Applicants, would have been led to make the combination recited in the claims." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). A determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. *See Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072 (Fed. Cir. 1994). The Examiner has failed to make such a showing.

In particular, Examiner relies on Jensen to show a product where vitreous fibers using conventional binder materials may be used, and further asserts that vitreous fibers have a composition similar to that which is claimed. But Jensen merely describes a typical "Rockwool" fiber composition, that is vastly different with respect to the content of Al<sub>2</sub>O<sub>3</sub>, MgO and the alkali components, and furthermore may not be fiberized by internal centrifugation process, but rather by more typical methods such as a spinning cup process or cascade rotor process (See col. 1, ll. 30-33, col. 2, ll. 52-58, col. 3, ll. 22-24, and col. 6, ll. 61-62). Jensen stresses the reduction of aluminum content in the fibers, and utilizes a melt process to combine the fibers (See col. 4, ll. 52-55), and therefore actually teaches away from Applicants' invention, as demonstrated, for example, in claim 14 where an Al<sub>2</sub>O<sub>3</sub> content is required which is well above the 10% maximum required by Jensen. Furthermore, Jensen does not disclose the surface weights of Applicants' claims 4 and 5. Thus, Jensen is not similar to the composition that is claimed by Applicants, nor

does Jensen teach or suggest Applicants' claimed invention. Battigelli and Vignesoult do not fill in the holes that are left by Jensen, as relied upon by the Examiner, as a teaching reference. Furthermore, Applicants point out to the Examiner that Battigelli and Vignesoult are commonly owned by the same assignee as the present application.

Additionally, it appears that the Examiner may be relying on statements of opinion or personal knowledge in arguing that the claimed invention would be obvious, without specific citations to any language from any one or more references. Specifically, Examiner suggests that it would have been obvious to one of ordinary skill in the art to adjust blower pressure to minimize the formation of beads. This motivation could clearly not come from Battigelli, as that reference does not disclose the binder or binder content, and does not provide any suggestion or motivation itself to adjust the blower pressure. Nowhere in Jensen is this motivation found either. Therefore, the Examiner must be relying on personal knowledge or opinion that one of ordinary skill in the art would have experimented to combine a spacer block with a particular guard rail assembly. That an element, property or component may have been within the province of the ordinary artisan does not in and of itself make an invention obvious absent clear and convincing evidence of such knowledge. *See C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). To the extent that the Examiner relies on personal knowledge regarding alleged obvious matters of design choice and/or well known manners of controlling the formation of beads during processing of mineral fibers, Applicants request an affidavit from the Examiner, pursuant to 37 C.F.R. 1.104(d), setting forth specific data and support for such rejection.

**Rejection of Claim 2 under 35 U.S.C. § 103(a):**

Claim 2 is rejected as being unpatentable over Battigelli in view of Bernard et al., Jensen and Viquesoult, and in further view of Balcerowiak. Applicants reassert their arguments made above in the preceding section with respect to the grounds for rejection based on 35 U.S.C. § 103, and further point out to the Examiner the following pertinent differences between Applicants' invention and Battigelli.

Battigelli differs first by its suggested content of MgO and also in the sum of its alkali components (namely Na<sub>2</sub>O and K<sub>2</sub>O). This reference also fails to disclose the fiber diameter or surface weight as claimed by Applicants. Battigelli also discloses such a high content of MgO

that Applicants assert it would not be soluble nor biodegradable, which is one aspect of Applicants' invention. In addition, in asserting that Micronaire values in Battigelli correspond to the raw densities claimed in Applicants' invention, the Examiner makes another error. Specifically, Micronaire is measured by several parameters, with fiber diameter being only one of those parameters, and therefore the values disclosed by Battigelli do not correspond to, nor do they suggest the raw densities claimed by Applicants. Balcerowiak vaguely mentions the use of certain binder materials in mineral wool insulation, but is silent as to the binder content, the fiber diameter, the surface weight as recited in claim 1, from which claim 2 depends, and therefore does not cure these defects.

In light of these arguments, and the amendment to claim 1 (from which claim 2 depends), Applicants respectfully request withdrawal of this ground for rejection.

**Rejection of Claims 8 and 12 under 35 U.S.C. § 103(a):**

Claims 8 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Battigelli in view of Jensen and Viquesoult, in further view of Audren et al. (U.S. Pat. No 4,928,898).

Claims 8 and 12 have been amended and are believed to be allowable. In addition, Audren, which is relied upon to teach the compression coiling technique, does not make claim 12 obvious. Audren is silent as to the use of glass cloth fleece, and also with respect to the application of a lamination in one processing step exempt of a thermal bridge. The Examiner's position that "the compression ratio is dependent on the thickness of the mineral fiber and may be adjusted for maximizing the amount of material shipped" is not sufficient to obviate claim 8, as there are many factors that affect the compression ratio, not just the thickness of the material. The Examiner appears to be relying on personal knowledge in rejecting claim 8, and to the extent Examiner does so rely on personal knowledge Applicants request an affidavit pursuant to 37 C.F.R. 1.104(d).

**Conclusion**

Applicants respectfully request the Examiner's reconsideration of Claims 1-14 and new Claim 15 in view of the amendments and the arguments presented above. If any issues remain, or if the Examiner believes that prosecution of this application might be expedited by discussion of these issues, the Examiner is invited to telephone the undersigned attorney for Applicants at the number below. Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Date: November 24, 2008

Respectfully submitted,

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